

REMARKS

By the foregoing amendments, claim 1 is revised, claim 14 is canceled, and new claim 15 is added to place this application in immediate condition for allowance.

Currently, claims 1-13 and 15 are before the Examiner for consideration on their merits.

First, the specification is revised to address the minor inconsistencies noted on page 2 of the Action and to include the claim language in the body of the specification. The Examiner's attention is also directed to the request for Title correction and it hopes that this change can be entered as part of this filing.

Second, claim 1 is revised in response to the rejection based on 35 U.S.C. § 112, second paragraph. Claim 1 now clearly defines the combination of the door support and the gasket. It is important to note that the combination is claimed since the manner in which the gasket interfaces with corner or corners of the doors is important in understanding the arguments in support of patentability as outlined below.

Support for the change to claim 1 in defining that the gasket is mounted on the one or more corners of the support is clearly found in the specification. The invention is directed to the problem of specially treating the prior art gaskets where the gasket interfaces with the corner of the door. Page 3, lines 5-17 clearly state that the gasket is designed to mount on the support that presents at least one corner of small radius. Therefore, to say that the gasket is mounted on each corner, which covers the scenario of one or more corners being present, is fully supported by the specification and a new matter issue is not raised.

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Certain of the changes to claim 1 can also be read to overcome the indefiniteness rejection raised under 35 U.S.C. § 112, second paragraph. Here, the Examiner contended that using the term "for mounting on the support" implied that the support was not part of the claimed combination. This problem is rectified by the change to claim 1, wherein combination is defined as the door support and the sealing gasket. With this change, the claim is now fully definite under 35 U.S.C. § 112, second paragraph and the rejection in this regard should be withdrawn.

Claim 1 is also revised to include a limitation of claim 14 regarding the connection of the base portion and the fixing portion. The remaining limitation of claim 14, i.e., that the base portion is substantially parallel to the fixing portion is now found in new claim 15.

Turning now to the rejection at hand, the revision to claim 1 to include a portion of claim 14 does not transform the rejection from one under 35 U.S.C. § 103(a) based on solely on Kawai et al. (Kawai) to one based on the combination of Kawai and Masuda. This is because the Examiner has considered the limitation that one end of the base portion connects to the elastically deformable portion to be found in Kawai since the claim language did not exclude a second end of the base portion being connected to the fixing portion.

To review and in response to Applicant's last reply, the Examiner took the position that Kawai is a single part gasket formed by extrusion that has its ends connected together by the molding section 13. Notwithstanding the correctness of this position, the new limitations at issue are believed to distinguish claim 1 from Kawai.

In the rejection, the Examiner appears to rely on both Figures 3 and 6 of Kawai to support the rejection. Figure 3 is cited to teach the following:

- 1) A flexible or semi-rigid portion 15;
- 2) an adhesive fixing the portion 15 to the support; and
- 3) an elastically deformable tubular portion 17 for providing sealing.

The Examiner then references Figure 6 to support the contention that the tubular portion of Kawai has a non-deformed cross-section in a free state and a deformed cross-section in a deformed state as shown in Figure 6. Reliance on the Figure 6 is used to address the limitations of claim 2.

It appears that Figure 5 is relied upon to allege that the elastically deformable portion of the gasket of Kawai shows a base portion that has both ends connected to the fixing portion 15. As mentioned above, the Examiner contends that the claim does not exclude a gasket having an elastically deformable portion with a base portion that is fixed to the fixing portion on both ends.

One point to highlight at this junction is that the gasket of Kawai depicted in Figure 2 has a number of cross sectional configurations as shown in the cross sectional views of Figures 3-7. In addition, Figure 2 shows that the gasket of Kawai is composed of an extruded gasket 14, whose ends are interconnected by a molding section 13. The molding section 13 is made so that it connects the two different ends of the extruded gasket 14, and occupies one corner of the support.

Based on the changes to claim 1 and submission of new claim 15, it is submitted that Kawai does not establish a *prima facie* case of obviousness against either of these claims. The traversal of the rejection is set out below under the headings of rejected claim 1 and newly added claim 15.

CLAIM 1

Claim 1 is revised in two ways to support the arguments of patentability. First, the gasket is defined as being mounted on each corner of the support. Second, the base portion of the elastically deformable portion is connected to the elastically deformable portion at **only** one end thereof. Since this limitation was already in claim 14 and not objected to for a lack of support, there is no need to further explain the basis for this revision. Support for the limitation regarding the corners of the support is addressed above.

Kawai fails to teach either of these newly added features of claim 1, and cannot be said to render this claim obvious under 35 U.S.C. § 103(a).

The limitation that the gasket is mounted on each corner of the support is not found in Kawai. In Kawai, it is specifically taught that the molded molding section 13 is associated with the corner of the support having a small radius, and then the different configurations of the extruded gasket are employed for the remainder of the support. This contrasts with the inventive gasket, wherein the gasket is mounted at the support corner or corners of small radius to solve the prior art problems associated with sealing in

the corners of the support. Therefore, it can be said that Kawai does not teach a gasket that is mounted on each such corner of a support.

While the Examiner could say that as long as Kawai teaches the gasket formed on one corner, that would be sufficient to meet the claim language, such an approach would be in error. Claim 1 defines the support as having at least corner of small radius of curvature, which means that the support could have one or more corners of small radius of curvature. The claim further requires that the gasket is mounted on each corner, and this means that gasket mounting occurs on either one corner if present or all the corners if more are present. This is not the case in Kawai, since the small radius corner shown in Figure 2 as the upper right corner does not have the gasket in question mounted to it at it. Instead, the molded molding section 13 covers the small radius corner, and the shape of this section is not even described.

The limitation in question here can also be said to require that the gasket is a single part for mounting on each corner, and this is clearly not the case in Kawai. Lacking this limitation, the Examiner cannot contend that Kawai teaches this aspect of the invention.

Further, there is no basis to conclude that the gasket of Kawai could be adapted to cover the small radius corner in Figure 2. While the Examiner could assert that one of skill in the art could form the extruded gasket of Kawai such that it is applied to the corner section 13, where would be the objective support for such a contention? Kawai specifically teaches that the section 13 is a molded section, with the remainder of the

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gasket being configured in different cross sectional shapes to accommodate the different shapes of the door. Since Kawai's aim was to reduce the number of molded sections, one would think that if it were possible, the molded section 13 would also be eliminated. However, the reason that the molded section of Kawai is present relates to the same problem faced by the inventors, i.e., how to effectively seal a corner of the door when the corner has a small radius of curvature. Clearly, Kawai has not solved this problem or the molded section 13 would also have been replaced. Therefore, the Examiner cannot legitimately conclude that one of skill in the art would be taught to replace the molded section 13 with an extruded section 14 of Kawai, particularly since each of the extruded sections 14 of Kawai is specifically designed for the support configuration, and none of these configurations even approximate the small radius of curvature corner of the support of Kawai. Applicants are the ones to solve the problem of sealing these types of support corners, and claim 1 is deserving of patent protection for this reason.

Notwithstanding the Examiner's agreement with the argument above, the argument below presents a separate reason why claim 1 is patentable over the applied prior art.

The limitation that the base portion is fixed **only** on one end to the fixing portion prevents the Examiner from reading the two ended connection of Kawai on claim 1. Thus, the Examiner now must either provide a reason why Kawai could be modified so that it reads on claim 1, as amended in this regard, or withdraw the rejection.

Applicants submit that the only proper course of action is to withdraw the rejection. As previously argued, the base of the sealing portion 17 of Kawai is connected to the fixing portion 15 at both ends as is apparent from Figures 2-7 of this patent.

Based on this fact, Kawai cannot be said to teach the feature of claim 1, where only one end of the base portion is fixed to the fixing portion. The question remains as to whether the Examiner can fashion a reasoning to support a contention that it would be obvious to attach the base portion of Kawai to the fixing portion at only one end. Applicants contend that there is no legitimate reasoning to draw this conclusion. An essential feature of the gasket of Kawai is the provision of a hollow space between the base portion and the fixing portion 15. This allows the fixing portion 15 to extend at a right angle to form the rear lip 29, which is essential given the fact that the gasket is used in a corner and requires support at the fixing portion and rear lip 29. With this criticality, one of skill in the art would not modify Kawai and make one of the base portion free as is required in claim 1.

If anything, Kawai would teach away from such a modification, and this teaching away is further substantiation of the failure of the prior art to establish a *prima facie* case of obviousness. Any allegation that it would be obvious to modify Kawai and arrive at the invention would be the hindsight reconstruction of the prior art, and any further rejection in this regard could not be sustained on appeal.

The configuration of claim 1 offers the advantage of avoiding any permanent stress on the adhesive and also to improve the closure energy of the door, see page 6, lines 8-

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10 of the instant specification. This is further substantiation of the unobviousness of the claimed gasket.

The above shows that Kawai cannot be used to establish a *prima facie* case of obviousness against claim 1. It is further contended that Masuda could not be employed to support a rejection under 35 U.S.C. § 103(a). Masuda and Kawai are contradictory in that they teach entirely different gaskets for door sealing. Whereas Kawai employs a single means to attach the gasket to the door, a clip or an adhesive, see col. 5, lines 10-12, Masuda requires a dual attachment of a clip and an adhesive. This alone precludes the Examiner's use of Masuda to somehow supply the deficiencies in Kawai.

Furthermore, even if the Examiner were to cite Masuda, Masuda does not teach the configuration of the base portion of the elastically flexible portion and the fixing portion. In Masuda, an essential part of the invention is the hollow space 5 for the clips between the base portion and the fixing portion. With this requirement for a hollow space for the clips, one of skill in the art would never see fit to modify Masuda such that only one end of the base portion would be connected to the fixing portion.

Thus, Masuda cannot cure the failings in Kawai and somehow support an allegation of obviousness.

CLAIM 15

As explained above, Claim 15 is added to further define the feature of the invention, wherein the base portion extends substantially parallel to the fixing portion.

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This feature is not taught or suggested by the combination of Kawai and Masuda and the rejection in this regard must be withdrawn.

The gasket of Kawai shows an elastically deformable portion 17 that has a base that is always oblique relative to the fixing portion 15. This contrasts with claim 15, which requires that the base portion of the elastically flexible portion be substantially parallel to the fixing portion.

In the rejection, the Examiner attempt to remedy the deficiency in Kawai by pointing to Masuda and alleging that a gasket configuration is known wherein a base portion of an elastically deformable portion is substantially parallel to a fixing portion and that it would be obvious to employ such in Kawai to better mount the gasket to the frame.

Applicants respectfully traverse the rejection that Kawai and Masuda establish obviousness when considering the claim limitation at issue.

First, it is argued that the rejection is improper since the Examiner has not supplied the proper reasoning to support the rejection. In the rejection, the Examiner speculates that the base portion of Kawai could be made parallel to the elastically flexible portion "to more securely mount the gasket to the frame." This reasoning is speculation on the part of the Examiner when taking into account the respective teachings of both Kawai and Masuda.

Masuda's invention is made to improve on the prior art embodiment of Figure 6 as described therein. As explained in paragraph [0008] of Masuda, the invention aims at solving the problem of the gasket of Figure 6 and the fact that the clip attachment portion

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102a and the tape attachment portion 102b "are adjacent each other and mutually in a parallel plane so that the clips 111 made of nylon or polyacetal resin will be melted out by the heated air."

Masuda solves this problem providing a gasket that has a first attachment face 2a equipped with clips 11 and a second attachment face 2b, which is equipped with the adhesive tape 12. This differs from the Figure 6 prior art in that the second attachment face 2b slants at an angle of 15 to 75 degrees to the first attachment face 2a.

The question here is whether one of skill in the art would be taught to modify Kawai, which teaches using an adhesive or clips to fix the gasket to the support, and use the teachings of Masuda, which requires both an adhesive and clips and an angled support as shown in Masuda's Figure 2. Since there is no angled support in Kawai or the need for a dual attachment as used in Masuda, why would one of skill in the art look to Masuda and use the Masuda arrangement in replacement of Kawai?

While the Examiner seems to suggest that one of skill in the art would be taught to use the prior art configuration of Masuda (Figure 6) in Kawai, this approach is even more suspect since Masuda teaches that such a configuration is inferior. One of skill in the art would not be led to use the inferior Figure 6 design of Masuda in replacement of the gasket of Kawai.

If anything, the only possible approach would be to say that one of skill in the art would be motivated to use the improved gasket of Masuda to improve Kawai. In this context, though, how would one of skill in the art employ the teachings of Masuda

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knowing Kawai? Would the artisan merely make a wholesale substitution by replacing the gasket of Kawai with the gasket of Masuda? Applicants contend that this approach is improper since Matsuda and Kawai are contradictory in this regard. Kawai is concerned with solving the problem of an excessive number of molded sections in a gasket and does so by creating a gasket that has a single molding section for an upper corner of the door and an extruded section that has different configurations to adapt to other parts of the door. To accomplish this aim, Kawai only needs to attach the gasket using an adhesive or clip, and the main thrust is the configuration of the extruded portion of the gasket along its length.

Masuda seeks to solve the problem of a dual attachment gasket using clips and adhesives, and the impairment of the clips when heating the adhesive for attachment. Masuda designs a specifically configured gasket such that the adhesive portion is angled with respect to the clip portion.

Given the two completely different problems and solutions of Kawai and Masuda, there is just no reason one of skill in the art would look to Masuda to modify Kawai as alleged by the Examiner. Kawai shows no need to have a dual attachment technique and to allege otherwise is hindsight. Therefore, the rejection is flawed on the grounds that the Examiner does not have a legitimate reason to combine modify Kawai as alleged in the Office Action.

Moreover, Masuda does not teach the claim limitation in question in any event and cannot establish a *prima facie* case of obviousness even if combined with Kawai. In

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Masuda, the fixing portion of Masuda must be construed to be both face 2a and face 2b. With this interpretation, the base portion of the elastically flexible portion 1 is not substantially parallel to the fixing portion 2a and 2b, and the limitation of claim 15 in this regard is not taught. Thus, even *assuming arguendo*, that one of skill in the art would be taught to use the dual attachment technique of Masuda in Kawai, Kawai would have a fixing portion that is angled with respect to a base portion of the elastically flexible portion.

The Examiner could merely pluck part of Masuda, i.e., the attachment portion 2a only, and say that it would be obvious to employ this aspect of Masuda in Kawai such that a base portion would exist that would be substantially parallel to a fixing portion. However, this approach would be tantamount to picking and choosing amongst select portions of the prior art to formulate a rejection under 35 U.S.C. § 103(a). This approach is not permissible and could not be sustained on appeal. As explained above, the dual attachment of Masuda is an essential part of the Masuda invention and to subdivide Masuda into parts to support the rejection is just improper.

In light of the above, claim 15 is separately patentable over Kawai and Masuda.

SUMMARY

In light of the amendments and arguments set forth above, the Examiner has failed to establish a *prima facie* case of obviousness against either of claims 1 or 15 based on the combined teachings of Kawai and Masuda. Therefore, the rejections as applied to

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claim 1 and the applied to rejected claim 14 must be withdrawn so that claim 1 and its dependent claims and claim 15 are allowed.

Accordingly, the Examiner is respectfully requested to examine this application in light of this amendment, and pass all pending claims onto issuance.

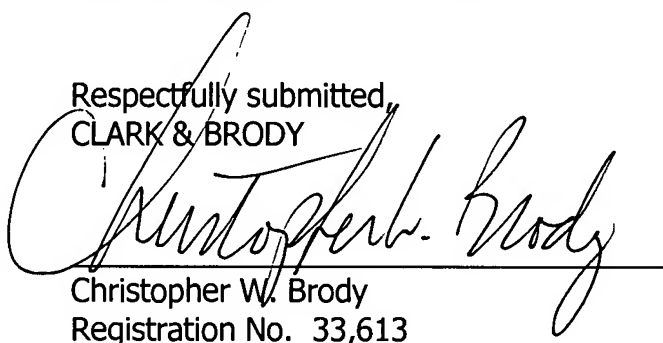
If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone or contact the undersigned using the information provided below.

Again, reconsideration and allowance of this application is respectfully requested.

The above constitutes a complete response to all issues raised in the Office Action dated May 17, 2007.

While there are no fees dues for extension of time payments, the U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency or credit any overpayment to Deposit Account No. 50-1088 with regard to this application.

Respectfully submitted,
CLARK & BRODY

A handwritten signature in black ink, appearing to read "Christopher W. Brody", is written over a horizontal line. The signature is fluid and cursive.

Christopher W. Brody
Registration No. 33,613

Customer No. 22902
1090 Vermont Ave., N.W., Suite 250
Telephone: 202-835-1111
Facsimile: 202-835-1755
Docket No.: 11016-0027
Date: July 3, 2007